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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91209617 |
| Party | Defendant Debra Wiseberg |
| Correspondence Address | DEBRA WISEBERG d/b/a BRAM WARREN CO 18100 SW 50TH ST SOUTHWEST RANCHES, FL 33331 1012 UNITED STATES bramwarren@bramwarren.com |
| Submission | Motion to Amend/Amended Answer or Counterclaim |
| Filer's Name | Debra Wiseberg |
| Filer's e-mail | bramwarren@bramwarren.com |
| Signature | /Debra Wiseberg/ |
| Date | 02/19/2015 |
| Attachments | Applicant's Motion for Leave to Amend Pleading.pdf(1085037 bytes) Brief in Support of Motion for Leave to Amend Pleading.pdf(1784665 bytes) Applicant's Second Amended Counterclaim.pdf(2927829 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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| Xikar, Inc., | 1 | |
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| | § | |
| Opposer, | § | Opposition No. 91209617 |
| | § | |
| v. | § | Mark: Cicar |
| | § | |
| Debra Wiseberg d/b/a | § | Serial No. 85/652496 |
| Bram Warren Company, | § | |
| | § | |
| Applicant. | § | |
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APPLICANT AND COUNTERCLAIM PLAINTIFF'S
MOTION FOR LEAVE TO AMEND (FRAUD) PLEADING

COMES NOW, Debra Wiseberg, Applicant and Counterclaim Plaintiff, (hereafter "Applicant" or "Counterclaim Plaintiff"), in this action pursuant to TBMP § 503.03; TBMP §507; Fed. R. Civ. P. 15; and 37 CFR §2.115, to respectfully request the Board grant the Applicant leave to amend the fraud pleading against the Opposer which was dismissed by the Board in their decision dated January 20, 2015 for failure to state a claim upon which relief can be granted. The Board was silent in their decision on whether or not the Applicant could amend the fraud pleading. The fraud claim was pled for the first time within the Applicant's Amended Counterclaim dated August 14, 2014. The Applicant has corrected the deficiency's the Board found in the fraud pleading and has more specifically pled such claim within the Applicant's Second Amended Counterclaim attached to this motion. If the Board grants the Applicant leave to amend the fraud pleading it will be the first amendment to such fraud pleading.

This motion for leave to amend pleading pertains only to the amendment of the fraud pleading against the Opposer. The Applicant's generic counterclaim against the Opposer has

been deemed sufficiently pled by the Board in their decision dated January 20, 2015 and remains incorporated into the Applicant's counterclaim to cancel the registration for the Opposer's mark "Xikar", US Registration No. 2200215 for the registered goods "cigar cutters".

The Applicant requests the Board accept the attached pleading and have the Opposer answer such pleading. The Applicant's Brief in Support of this motion and proposed Second Amended Counterclaim are attached to this motion for the Board's consideration. The Applicant has concurrently filed a motion for reconsideration of decision on motion regarding the fraud claim.


Dated: February 19, 2015

Respectfully submitted,

By: 
Debra Wiseberg
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Telephone No.: (954) 297-0329
Email: bramwarren@bramwarren.com

CERTIFICATE OF FILING

I hereby certify that the Applicant and Counterclaim Plaintiff's Motion for Leave to Amend (Fraud) Pleading, Brief in Support of the Applicant and Counterclaim Plaintiff's Motion for Leave to Amend (Fraud) Pleading, and Applicant's Second Amended Counterclaim were filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on February 19, 2015.

By: 
Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant and Counterclaim Plaintiff's

Motion for Leave to Amend (Fraud) Pleading, Brief in Support of the Applicant and
Counterclaim Plaintiff's Motion for Leave to Amend (Fraud) Pleading, and Applicant's Second
Amended Counterclaim were sent to the counsel for the Opposer by the United States Postal
Service, first class mail on February 19, 2015 to the following address:

Ginnie C. Derousseau
Erickson, Kernell, Derousseau & Kleypas LLC
8900 State Line Road, Suite 500
Leawood, KS 66206

By: _____


Debra Wiseberg

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Xikar, Inc.,

Opposer,

v.

Debra Wiseberg d/b/a
Bram Warren Company,

Applicant.

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Opposition No. 91209617

Mark: Cicar

Serial No. 85/652496

BRIEF IN SUPPORT OF APPLICANT AND COUNTERCLAIM PLAINTIFF'S
MOTION FOR LEAVE TO AMEND (FRAUD) PLEADING

I. INTRODUCTION

The Applicant's fraud claim against the Opposer to cancel the mark "Xikar", was originally pled in the Applicant's Amended Counterclaim dated August 14, 2014 and was dismissed by the Board in their decision dated January 20, 2015 for failure to state a claim. The Board was silent in their decision on whether or not the Applicant could amend the fraud pleading. This ground was pled only once by the Applicant in the Applicant's Amended Counterclaim dated August 14, 2014.

Pursuant to TBMP §503.03; TBMP § 507; and Fed. R. Civ. P. 15, which states "a party may amend its pleading with the court's leave. The court should freely give leave when justice so requires", the Applicant respectfully requests that the Board grant the Applicant leave to amend the fraud counterclaim to correct the deficiencies found by the Board in the Applicant's original fraud pleading.

This motion for leave to amend pleading pertains only to the amendment of the fraud pleading against the Opposer. The Applicant's generic counterclaim against the Opposer has

been deemed sufficiently pled by the Board in their decision dated January 20, 2015 and remains incorporated into the Applicant's counterclaim to cancel the registration for the Opposer's mark "Xikar", US Registration No. 2200215 for the registered goods "cigar cutters".

II. LEGAL STATUTES

Fed. R. Civ. P. 15, states "a party may amend its pleading with the court's leave. The court should freely give leave when justice so requires". 37 CFR §2.115, states "pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in the United States district court". TBMP § 503.03, states "a plaintiff may amend its complaint by leave of the Board, which is freely given when justice so requires.

III. ARGUMENTS

The Applicant pled the fraud claim in a timely manner after learning during this proceeding of the use and non-use of the mark by the Opposer and Kurt Van Keppel. Upon learning this information and researching the matter, the Applicant brought such claim promptly in the Applicant's Amended Counterclaim filed on August 14, 2014. The timeliness of the filing of such fraud claim having been deemed reasonable by the Board in their decision dated January 20, 2015.

The Applicant pled the fraud claim for the first time within the Applicant's Amended Counterclaim dated August 14, 2014. This is the Applicant's first and only request to amend such fraud claim and if the Board grants the Applicant leave to amend such claim, it will be the first amendment to such claim. As the courts have freely granted leave when justice so requires, the Applicant is requesting the Board grant her leave to amend the fraud claim as proposed in the Applicant's Second Amended Counterclaim attached to this motion. "The Board freely grants leave to amend pleadings found, upon challenge under Fed R. Civ. P. 12(b)(6), to be insufficient,

particularly where challenged pleading is the initial pleading.” Miller Brewing Co.v Anheuser-Busch In., 27 USPQ2d 1711, 1714 (TTAB 1993).

The Applicant has put forth arguments within her motion for reconsideration of decision on motion (dismissal of fraud claim) filed concurrently with this motion, that I request the Board consider when deciding this motion.

IV. CONCLUSION AND REQUEST

This motion for leave to amend pleading pertains only to the amendment of the fraud pleading. The Applicant’s generic counterclaim was deemed sufficiently pled by the Board in their decision dated January 20, 2015. The generic counterclaim remains incorporated into the Applicant’s counterclaim for cancellation of the Opposer’s mark Xikar”, US Registration No. 2200215 for the registered goods “cigar cutters”, as previously set forth in the Applicant’s Amended Counterclaim dated August 14, 2014, and answered by the Opposer on February 9, 2015.

The Applicant by filing this motion is requesting the Board grant her leave to amend the fraud counterclaim pleading that the Board dismissed in their decision dated January 20, 2015, for failure to state a claim. The Board was silent in their decision on whether or not the Applicant could amend the fraud pleading (TBMP § 503.03). This is the Applicant’s first request to amend the counterclaim against the Opposer. The Applicant has only pled the fraud claim once within the Applicant’s Amended Counterclaim dated August 14, 2014; such amendment filed in response to the Board’s decision dated July 18, 2014. If the Board grants the Applicant leave to amend the fraud pleading against the Opposer, then such amendment will be the first amendment to the fraud claim. The Applicant has corrected the deficiencies the Board found in the fraud

pleading in their decision dated January 20, 2015, within the Applicant's proposed Second Amended Counterclaim attached to this motion. The Applicant is requesting the Board accept such amended pleading and have the Opposer file an answer to such pleading.


Dated: February 19, 2015

Respectfully submitted,

By: 
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Email: bramwarren@bramwarren.com

CERTIFICATE OF FILING


I hereby certify that the Applicant and Counterclaim Plaintiff's Motion for Leave to Amend (Fraud) Pleading, Brief in Support of Motion for Leave to Amend (Fraud) Pleading, and Applicant's Second Amended Counterclaim were filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on February 19, 2015.

By: 
Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant and Counterclaim Plaintiff's Motion for Leave to Amend (Fraud) Pleading, Brief in Support of Motion and Applicant's Second Amended Counterclaim were sent to the counsel for the Opposer by the United States Postal Service, first class mail on February 19, 2015 to the following address:

Ginnie C. Derousseau
Erickson, Kernell, Derousseau & Kleypas LLC
8900 State Line Road, Suite 500
Leawood, KS 66206

By: 
Debra Wiseberg

and the translation and meaning of “xikar” is “cigar”; the genus of the Opposer’s goods are cigar accessories and cigars. Paragraph No. 5 of the Applicant’s Amended Counterclaim dated August 14, 2014.

3.) Pursuant to Trademark Act §14(3); 15 U.S.C. § 1064(3); and based on the allegations contained herein, US Registration No. 2200215 for the trademark “Xikar” for “cigar cutters” should be canceled due to the fact that “xikar” is a translation of the word “cigar” and therefore the Opposer’s mark “Xikar” is generic in nature; the Opposer has tried to have consumers pronounce their mark “Xikar” as “cigar”; and the Opposer has used the “Xikar®” mark in the sale and promotion of “cigars”. Paragraph No. 26 of the Applicant’s Amended Counterclaim dated August 14, 2014.

The Applicant’s generic counterclaim for cancellation of the Opposer’s mark “Xikar” US Registration No. 2200215 for the registered goods “cigar cutters”, as previously set forth (and answered by the Opposer on February 9, 2015) remains incorporated into the Applicant’s counterclaim for cancellation.

II. FRAUD - TRADEMARK ACT §14(3); 15 U.S.C. § 1064(3)

Pursuant to Trademark Act §14(3); 15 U.S.C. § 1064(3) and based on the following allegations contained herein, US Registration No. 2200215 for the mark “Xikar” for the registered goods “cigar cutters” should be canceled because it was fraudulently obtained and maintained by Kurt Van Keppel and the Opposer.

1.) Kurt Van Keppel, co-founder and President of Xikar, Inc. and predecessor in interest to the “Xikar” mark, and the Opposer, Xikar, Inc., a Kansas corporation, did knowingly make false, material misrepresentations of fact within documents filed with the USPTO with the

intent to deceive the USPTO, and in so doing, fraudulently obtained and maintained the registration of the “Xikar” trademark.

2.) Xikar, Inc., a Kansas for Profit Corporation, of which Kurt Van Keppel is co-founder and President, was formed on February 5, 1996 to engage in “wholesale and retail cigar cutter sales.” Kurt Van Keppel falsely swore on July 24, 1996 in the affidavit filed with the application to register the “Xikar” mark, such application filed in the name of Kurt Van Keppel, an individual, that to the best of his knowledge and belief no corporation had the right to use the mark in commerce. Kurt Van Keppel, an individual did not hold the right and control over the use of the “Xikar” mark.

3.) The Opposer and Kurt Van Keppel did knowingly and fraudulently file the trademark application for the mark “Xikar” in the name of Kurt Van Keppel, an individual for the registered goods “cigar cutters”, to avoid the inability to register a “corporation and trade name” with the intent to deceive the USPTO and prevent the USPTO from properly scrutinizing the mark during the application process.

4.) Kurt Van Keppel did knowingly and fraudulently make false, material misrepresentations of fact in the section 1(b) application of bona fide intention to use the “Xikar” mark in interstate commerce, and affidavit filed with such application with the intent to deceive the USPTO. Kurt Van Keppel falsely swore in his affidavit dated July 24, 1996 and filed with the application to register the “Xikar” mark in the name of Kurt Van Keppel, an individual, that, “Applicant has a bona fide intention to use the mark in commerce; that “he believes himself to be the owner of the mark sought to be registered”; and that “to the best of his knowledge and belief that no other person, firm, corporation or association had the right to use the mark in commerce”.

5.) Kurt Van Keppel did knowingly and fraudulently make false, material misrepresentations of fact in obtaining the registration of the “Xikar” trademark with the intent to deceive the USPTO as both Kurt Van Keppel and the Opposer knew the mark “Xikar” was not being used by Kurt Van Keppel, an individual, in interstate commerce between the dates of February 6, 1997 and March 25, 2004 and proceeded to make false statements of use by Kurt Van Keppel, an individual within affidavits filed with the USPTO.

6.) Kurt Van Keppel did knowingly and fraudulently make false, material misrepresentations of fact with the intent to deceive the USPTO in the Statement of Use filed on December 8, 1997 in which Kurt Van Keppel, an individual falsely swore that “Applicant believes it is the owner” of the “Xikar” mark and that “Applicant is using the mark in commerce”. The Statement of Use filed on December 8, 1997 was deemed insufficient in the Office Action letter dated January 30, 1998 due to the specimens and “use of mark in interstate commerce” statement submitted, and the USPTO informed the Applicant in such letter of the improper use of the registration symbol. The USPTO stated in the Office Action letter dated January 30, 1998, that the statement “applicant continues to use the mark in interstate commerce” was required in such filing. Kurt Van Keppel submitted a new declaration where language indicating use of the mark by the Applicant was omitted. The inclusion and removal of such direct language of use indicates knowledge with the intent to deceive.

7.) Kurt Van Keppel and the Opposer did knowingly transfer rights to an invalid trademark registration with the intent to deceive the USPTO, and in so doing, the Opposer fraudulently obtained and maintained the registration for the mark “Xikar”.

8.) The Opposer and Kurt Van Keppel filed the Assignment of the “Xikar” trademark on April 6, 2004 while knowingly making false, material misrepresentations of fact within such transfer of the mark. Both parties to the Assignment knew Kurt Van Keppel, an individual did not use the mark in interstate commerce between the dates of February 6, 1997 and March 25, 2004 and both parties knew Kurt Van Keppel, an individual did not have a business to transfer pertaining to the “Xikar” mark and therefore had no valid right, title or interest in the registration for said mark. By filing the Assignment while knowing it contained false, material misrepresentations of fact, the Opposer and Kurt Van Keppel did commit fraud with the intent to deceive the USPTO.

9.) The filing of the Assignment of the “Xikar” registration immediately before the filing of the Declaration of Use and Incontestability by Xikar, Inc., under Sections 8 & 15 on April 15, 2004 indicates knowledge by both Kurt Van Keppel and the Opposer that the registration was invalid and shows intent to deceive the USPTO.

10.) The Opposer filed the Declaration of Use and Incontestability under Sections 8 & 15 on April 15, 2004, knowing that the registration for the mark “Xikar” was invalid and that documents filed in connection with the mark contained false, material misrepresentations of fact, and by filing these affidavits deceived the USPTO and gained protections that they were not entitled to and should not be rewarded with.

11.) The Opposer has knowingly and fraudulently used the registration symbol ® with the “Xikar” mark on goods for which they were not entitled and for which the mark is not registered after being informed by the USPTO in the Office Action letter dated January 30, 1998 that the *Applicant (Kurt Van Keppel)* improperly used the registration symbol and that “after the


registration of the mark, the Applicant (*Kurt Van Keppel*) may use the symbol only with the specific goods or services recited in the registration”.

12.) The Opposer and Kurt Van Keppel did knowingly and fraudulently make a false (omission), material misrepresentation of fact by not disclosing the translation of the “Xikar” mark with the intent to deceive the USPTO and prevent the USPTO from properly scrutinizing the mark during the application process in an attempt to obtain invalid rights to the word “cigar” and is now attempting to enforce such rights through their opposition case against the counterclaimant.

WHEREFORE, the Applicant is damaged by the federal trademark registration for the mark “Xikar” and prays that the Board will grant her counterclaim against the Opposer and cancel US Registration No. 2200215 for the trademark “Xikar” for the registered goods “cigar cutters”.

Dated: February 19, 2015

Respectfully submitted,

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CERTIFICATE OF FILING

I hereby certify that the Applicant’s Second Amended Counterclaim was filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on February 19, 2015.

By: 
Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant's Second Amended Counterclaim was sent to the counsel for the Opposer by the United States Postal Service, first class mail on February 19, 2015 to the following address:

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